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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,928	01/28/2002	Shigetoshi Sasano	2001_1923A	1452

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EXAMINER
SERGENT, RABON A

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/055,928	SASANO ET AL.
	Examiner	Art Unit
	Rabon Sergent	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Claims 1, 2, and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Within claim 1, applicants have claimed that the cyclic ester compounds are eluted through a film layer of a composite film; however, the specification appears to only discuss elution from the composite film, rather than a film layer.

2. Claims 1, 2, and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to the method by which the concentrations of the cyclic ester compounds and cyclic urethane compounds are determined, it is unclear to what extent the films, bonded by the adhesive must be controlled or limited. It is unclear if the results are accurate or repeatable regardless of the composition of the adhered films. For example, it is unclear to what extent the results would be affected if polyester films, derived from an acid other than naphthalenedicarboxylic acid, were bonded by the adhesive and tested. Similarly, it is unclear what effect would result if the films, bonded with the instant adhesive, were derived from naphthalenedicarboxylic acid.

3. The examiner has considered applicants' response; however, the response is insufficient to overcome the rejection. Applicants have claimed a laminate adhesive, as opposed to a composite film; however, applicants are attempting to rely on the properties of the composite

film to convey patentable distinction or limitation to the adhesive, regardless of the composition of the adhered films. Applicants have in no way established that the concentrations obtained for the cyclic compounds are independent of the composition or thickness of the adhered films; therefore, it is not seen that applicants have addressed the examiner's concerns. Since it has not been established that the composition or dimensions of the adhered films do not have an impact on the obtained concentrations, there is no way of determining if or to what extent the claimed concentrations are constant limitations as opposed to being relative limitations. The situation is analogous to setting forth a test value without setting forth the test standard.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al. ('820).

Patentees disclose polyurethane laminating adhesive compositions comprising a polyester polyol, derived from naphthalenedicarboxylic acid. See columns 2, 3, and 7, and examples. Since the polyurethane is derived from a polyester polyol that meets the polyol claimed by applicants, the position is taken that the claimed concentrations of cyclic compounds are inherent characteristics of the disclosed composition.

6. The examiner has carefully considered applicants' response; however, the response is not commensurate in scope with the claims. Despite applicants' argument, the claims merely require a polyester polyol of the adhesive to be derived from naphthalenedicarboxylic acid and, optionally, a dimer acid and/or phthalic acid. This polyester polyol is clearly met by patentees' component (B). Applicants' claims do not exclude the presence of other polyols, including polyols derived from adipic acid. Additionally, the examiner has considered the declaration, filed June 27, 2003; however, the declaration fails to set forth any convincing evidence that the adhesive of the prior art does not inherently meet the claimed cyclic compound concentrations. The polyurethane of the declaration does not have a composition which is even remotely similar to the composition of the Goto et al. polyurethane.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent

September 8, 2003